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EXAMINER	
SUAREZ, FELIX E	

ART UNIT	PAPER NUMBER
2857	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/577,041

Applicant(s)

NAKANO ET AL.

Examiner

Felix E. Suarez

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-17 is/are rejected.
- 7) ☒ Claim(s) 6-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 24 April 2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Abstract

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 10 and 12-17 are rejected under 35 U.S.C. 102(b) as being unpatentable over Goetz et al. (U.S. Patent No. 6,421,650).

With respect to claims 1, 13 and 14 Goetz et al. (hereafter Goetz) teaches a mobile medication history management apparatus (or a memory card or a method), comprising:

an obtaining unit operable to obtain identification information relating to a drug that a user of the medication history management apparatus is planning to take (see col. 2, lines 21-32, medical history; and col. 4, lines 59-61, identify the type of pill to be taken);

a secure storage unit operable to store, in a secure storage area therein, medication history information of a drug that the user has taken previously (see col. 4, lines 25-32, memory device is a smart card); an information storage unit operable to store mutual effect information showing one or more mutual effects, each mutual effect being caused by taking of drugs in combination (see col. 4, lines 62-65, possible side effects and potential interactions with other drugs);

a judgment unit operable to refer to the stored mutual effect information to check whether any combinations exist therein of the drug shown by the obtained identification information and any of the previously taken drugs estimated to have a remaining physical effect in the user (see col. 6, lines 4-19, a code to identify every medication, supply necessary information about the prescribed medication to the patient cautions and possible side effects), in order to judge whether a mutual effect will occur due to taking the drug shown by the obtained identification information and any of the previously taken drugs (see col. 4, lines 62-65, possible side effects and potential interactions with other drugs; and col. 15, lines 46-64, possible drugs which can interact with set of prescribed drugs); and

an output unit operable to output a judgment result (see col. 4, lines 44-49, display for medical data contained in the memory).

With respect to claim 2, Goetz further teaches, each of the drug that the user is planning to take and the one or more previously taken drugs is a one of a prescription drug and non-prescription drug (see col. 16 line 64 to col. 17 line 12,

a patient can enter any over the computer medication that she or he may choose to consume and warning should be displayed involving interaction with prescribed medications).

With respect to claim 3, Goetz further teaches comprising:

a first download unit operable to download mutual effect information from an external server, and store the mutual effect information in the information storage unit (see col. 16 line 64 to col. 17 line 12, a patient can enter over the computer any medication, store in a database, that she or he may choose to consume and a warning indication should be displayed involving interaction with prescribed medications).

With respect to claim 4, Goetz further comprising:

a second download unit operable to download medication history information from a server that is one of a hospital server and a pharmacy server, and store the medication history information in the secure storage unit (see col. 6, lines 44-47, Patient Medication Consumption History Log in a smart card memory device).

With respect to claims 5 and 17, Goetz further teaches,

when the second download unit downloads the medication history information (see col. 6, lines 44-47, Patient Medication Consumption History Log

in a smart card memory device), the second download unit and the server perform mutual authentication processing, writing of the downloaded medication history information to the secure storage unit being permitted only when authentication succeeds (see col. 10, lines 16-31, prescription and medical history; and patient's user password).

With respect to claim 10, Goetz further teaches a mobile terminal that is equipped with a secure memory card (see col. 6, lines 20-28, smart card).

With respect to claim 12, Goetz further teaches that, the memory card is detachably mounted in the mobile terminal (see col. 6, lines 20-28; FIG. 1, smart card).

With respect to claim 15, Goetz further teaches comprising:

a first download step of obtaining mutual effect information from an external server, and storing the mutual effect information in the information storage unit (see col. 16 line 64 to col. 17 line 12, a patient can enter over the computer any medication, store in a database, that she or he may choose to consume and a warning indication should be displayed involving interaction with prescribed medications),

the first download step being performed in a routine that is separate to a processing sequence that includes the obtaining step though to the output step

(see col. 7, lines 27-42, the patient wishes to view the underlying record for a particular entry on the screen, as desired).

With respect to claim 16, Goetz further comprising:

a second download step of downloading medication history information from a server that is one of a hospital server and a pharmacy server, and updating contents of the secure storage unit with the downloaded medication history information (see col. 6, lines 44-47, Patient Medication Consumption History Log in a smart card memory device),

the second download step being performed in a routine that is separate from the processing sequence (see col. 5, lines 57-64, a smart card reader software resides on the pharmacist's personal computer).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 11, is rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (U.S. Patent No. 6,421,650) in view of Arnouse (U.S. Patent No. 7,013,365).

With respect to claim 11, Goetz et al. (hereafter Goetz) teaches all the features of the claimed invention, except that Goetz does not teach that, the mobile terminal is a mobile telephone.

But Arnouse teaches in a system of secure personal identification, information processing, and precise point of contact location and timing that, the terms interface and host device should be broadly comprise any device having the capability for communication with the processing device/identification memory card reader and/or the storage device/identification memory card, where desired. For example, the host device may comprise a separate device, such as a telephone, capable of interfacing with the identification card reader (see Arnouse; col. 3, lines 47-54).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Goetz to include a host device such as telephone, as taught by Arnouse, because the host device as the telephone allows to communicate with a patient in order to optimally schedule the administration of medications in accordance with the patient's general activity patterns (see Goetz; col. 10, lines 28-35), as desired.

Allowable Subject Matter

4. Claims 6-9, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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5. The following is a statement of reasons for the indication of allowable subject matter:

Claims 6-9, would be allowable over the prior art for at least the reason that the prior art fail to teach or suggest:

wherein, when making the judgment, if the counted time of a previously taken drug in combination with the planned drug in the medication history information is less than the physical effect remain time of the previously taken drug, the judgment unit selects drug identification information of the previously taken drug as a target of comparison, and if the counted time of a previously taken drug in combination with the planned drug exceeds the physical effect remain time of the previously taken drug, the judgment unit excludes the drug identification information of the previously taken drug from being a target of comparison.

Conclusion

Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Haitin et al. [U.S. Patent No. 7,155,306] describes a method for administering medications to a plurality of patients.

Stoll et al. [U.S. Patent No. 6,985,869] describes a digital prescription carrier.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix Suarez, whose telephone number is (571) 272-2223. The examiner can normally be reached on weekdays from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eliseo Ramos-Feliciano can be reached on (571) 272-7925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and for After Final communications.

June 19, 2007

F.S.


ELISEO RAMOS-FELICIANO
SUPERVISORY PATENT EXAMINER